

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#19/20

APPLICANTS: Clifford L. Hersh et al.

SERIAL NO.: 09/701,797

FILING DATE: December 1, 2000

TITLE: Method for Increased Concurrency in a Computer System

EXAMINER: Unknown

ART UNIT: Unknown

ATTY. DKT. NO.: PA1675US

RECEIVED

JAN 05 2005

OFFICE OF PETITIONS

RECEIVED

MAR 10 2004

Technology Center 2100

Certificate of Express Mailing Under 37 C.F.R. § 1.10

I hereby certify the correspondence attached hereto is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" Express Mail Number EL 504 270 015 US under 37 C.F.R. § 1.10 on 25 September 2003 and is addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, VA 22313-1450.

By:


V. Randall Gard, Reg. No. 33,886

Mail Stop PCT
Commissioner for Patents
Attn: Office of PCT Legal Administration
P.O. Box 1450
Alexandria, VA 22313-1450

Renewed Petitions Under 37 CFR 1.47(a) and 1.137(b)

SIR:

Background

This petition relates to a series of petitions for revival of an abandoned patent application pursuant to 37 CFR 1.137(b) for unintentional abandonment and 37 CFR 1.47(a) as to the declaration requirements where there exists an uncooperative or unavailable inventor.

In a prior *Decision on Petition Under 37 CFR 1.47(a) and Renewed Petition Under 37 CFR 1.137(b)*, Petitions Attorney Putonen noted the requirements of a 1.47(a) petition and its applicability “only where a **known** legal representative of a deceased inventor cannot be found or reached after diligent effort, or refuses to make application. In such cases, the last known address of the legal representative must be given” (emphasis in the original). Petitions Attorney Putonen further noted that where the *legal representative* of an inventor is deceased, the applicant must seek out the “current legal representative.”

Additionally, in a prior *Decision on Renewed Petition Under 37 CFR 1.137(b)*, the elements of a proper declaration under 37 CFR 1.497(a) and (b) were set forth in light of a 1.47(a) petition.

In response to these prior petition decisions, namely the *Decision on Renewed Petition under 37 CFR 1.137(b)* mailed 25 July 2003, applicants submit the following request for reconsideration based on the identification of a present legal representative for the estate of a deceased inventor pursuant to 37 CFR 1.47(a) and the delivery of a proper declaration pursuant to 37 CFR 1.497.

Statement of Facts

Applicants contacted the Surrogate’s Court of the County of New York—the court of competent jurisdiction for probate of Mrs. Todd’s estate based on her last known address. The Surrogate’s Court of the County of New York provided the applicable information for the attorney and fiduciary of the Joan Todd estate. The information provided by the Surrogate Court of the County of New York is attached herein as *Exhibit A*.

On 15 September 2003, attorneys for the applicant contacted Mr. Ralph M. Engel, attorney for the estate of Mrs. Joan Todd, via telephone (Declaration of Colby B. Springer, attached herein as *Exhibit B*). Mr. Ralph M. Engel confirmed he represented the estate of Mrs. Joan Todd and that Mr. Dominic Gaeta was the executor and beneficiary of the estate; Mr. Engel also informed applicants’ attorneys that Mr. Gaeta was a client of his firm. *Id.* Attorneys for the applicant explained the present declaration situation brought about by the present series of petitions and requested Mr. Gaeta’s assistance as executor of the estate in executing the requisite oath or declaration. *Id.*

Mr. Engel, as legal counsel for Mr. Gaeta—the executor Mrs. Todd’s estate—requested the delivery of a letter detailing the situation along with the requisite supporting documentation; attorneys for the applicant complied (*Exhibit B*) and

enclosed, via Express Mail, a copy of the application and a *Declaration and Power of Attorney for Patent Application*, attached herein as *Exhibit C*.

To date, neither Mr. Gaeta nor Mr. Engel, as legal counsel for the estate and Mr. Gaeta, have responded as to whether the declaration for the present application will be executed (*Exhibit B*).

Renewed Petition Under 37 CFR 1.47(a)

A petition under 37 CFR 1.47(a) is appropriate when "a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort."

The co-inventor for the present application, Herbert Sullivan, is deceased. Mr. Sullivan's legal representative and heir was, initially, Mrs. Joan Todd. Mrs. Todd, however, is now deceased. Applicants note the limitations of 37 CFR 1.47(a) as set forth in MPEP 409.03(c) where a petition under 1.47 is generally inapplicable since the language "cannot be found or reached after diligent effort has no reasonable application to a deceased inventor." As such, applicants have sought out the current legal representative of the estate.

Applicants, as noted by *Exhibit A*, have sought out and acquired the requisite contact information for the present legal representative of the estate of Mr. Sullivan via the estate of Mrs. Todd. That representation has been confirmed by attorneys' conversations with Mr. Engel (*Exhibit B*).

A proper 37 CFR 1.47(a) requires the following:

- (1) an oath or declaration of the signing co-inventor;
- (2) a petition including proof of the pertinent facts;
- (3) the fee set forth in 37 CFR 1.17(h);
- (4) the last known address of the non-signing inventor.

Applicants have previously submitted the requisite oath and declaration of the signing co-inventor, Clifford Hersh. The Petitions Attorney has recognized the declaration of Mr. Hersh *is proper and without defect* in a telephone conversation of 28 June 2002.

Applicants contend the present petition's *Statement of Facts*, in conjunction with the accompanying declaration and exhibits, satisfy the requirement of proof of pertinent facts.

The fee for this petition has been previously charged to the appropriate deposit account. See 3 October 2002 *Decision of Petition Under 37 CFR 1.47(a) and Renewed Petition Under 37 CFR 1.137(b)* and Conclusion of 25 July 2003 *Decision of Renewed Petition Under*

37 CFR 1.137(b) ("[n]o additional fee is required"). Should an additional fee be required, however, applicants continue to authorize the Commissioner to charge such fee to Deposit Account 06-0600.

The last known address of the non-signing inventor is that of Mr. Sullivan (deceased) on his behalf by Mrs. Joan Todd as legal representative (deceased) on her behalf by Mr. Dominic J. Gaeta as legal representative and represented by Mr. Ralph M. Engel (*See Exhibit A and Exhibit B*).

The address of Mr. Gaeta (executor of Mrs. Joan Todd's estate) is: **533 Lotus Road, Ridgewood, New Jersey, 07450-5213.**

The address of Mr. Engel (legal representative of Mr. Gaeta) is: **Sonnenschein Nath & Rosenthal, 1221 Avenue of the Americas, New York, New York, 10020-1089.**

Additionally, applicants bring to the Examiners' attention the delivery of a declaration to the legal representative of Mr. Sullivan/Mrs. Todd's estate as set forth by 37 CFR 1.497(a)-(b) (*Exhibit C*). Namely, the delivered declaration addressed the Petitions Attorney's 25 July 2003 newly identified objections in that:

- (1) the declaration was delivered for execution by the present legal representative;
- (2) the declaration identifies the citizenship of Mr. Sullivan and identifies Mr. Hersh as a joint inventor;
- (3) the requisite declaration under 37 CFR 1.497(a)(4) stating that the person making the oath or declaration believes that the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought is included; and
- (4) the requisite declaration under 37 CFR 1.63 as to the signee having reviewed and understands the content of the application and that they acknowledge the duty to disclose to the USPTO all information known to be material to patentability

Renewed Petition Under 37 CFR 1.1.137(b)

A proper petition under 37 CFR 1.137(b) requires:

- (1) the petition fee required by law;
- (2) a statement that the entire delay in filing the required reply was unintentional;
- (3) any terminal disclaimer pursuant to 37 CFR 137(c) (where required); and
- (4) the required reply.

Applicants previously satisfied the first three requirements leaving only the submission of the required reply to revive the application. *See 30 May 2002 Decision on Petition Under 37 CFR 1.137(b).*

Applicants contend the present *Renewed Petition Under 37 CFR 1.47(a)* in conjunction with the previously submitted and accepted declaration of Clifford Hersh hereby satisfies the requirement as to a proper reply.

CONCLUSION

In view of the foregoing, a decision in favor of a revival of the present application is respectfully requested.

If the Examiner believes that a conference would facilitate prosecution of this application, the Examiner is invited to telephone Applicants' undersigned representative at the number set out below.

Respectfully submitted,
Clifford L. Hersh et al.

Date: 25 September 2003

By: _____


V. Randall Gard, Registration No. 33,886
Carr & Ferrell LLP
2225 E. Bayshore Road, Suite 200
Palo Alto, California 94303
Phone (650) 812-3400
Fax (650) 812-3444

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/701,797	
	Filing Date	December 1, 2000	
	First Named Inventor	Hersh	
	Art Unit	Unknown	
	Examiner Name	Unknown	
Total Number of Pages in This Submission	9	Attorney Docket Number	PA1675US

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input checked="" type="checkbox"/> Petition (Supplement) <input type="checkbox"/> Petition to Convert to a Provisional Application <input checked="" type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): <small>(1) Declaration and Power of Attorney by Legal Representative; (2) Confirmation Postcard</small>
Remarks Total page number does not include postcard.		

RECEIVED

MAR 19 2004

Technology Center 2100

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Carr & Ferrell LLP
Signature	<i>V. Randall Gard</i> Reg. No. 33,886
Date	December 19, 2003

CERTIFICATE OF TRANSMISSION/MAILING	
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.	
Typed or printed name	V. Randall Gard
Signature	<i>V. Randall Gard</i> Date December 19, 2003

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

RECEIVED

JAN 05 2005

OFFICE OF PETITIONS

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Clifford L. Hersh et al.

SERIAL NO.: 09/701,797

FILING DATE: December 1, 2000

TITLE: Method for Increased Concurrency in a Computer System

EXAMINER: Unknown

ART UNIT: Unknown

ATTY. DKT. NO.: PA1675US

RECEIVED

MAR 19 2004

Technology Center 2100

Certificate of Express Mailing Under 37 C.F.R. § 1.10

I hereby certify the correspondence attached hereto is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" Express Mail Number EV 400 681 959 under 37 C.F.R. § 1.10 on 19 December 2003 and is addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, VA 22313-1450.

By:



V. Randall Gard, Reg. No. 33,886

Mail Stop PCT

Commissioner for Patents

Attn: Office of PCT Legal Administration

P.O. Box 1450

Alexandria, VA 22313-1450

RECEIVED

JAN 05 2005

OFFICE OF PETITIONS

Supplement to
Renewed Petitions Under 37 CFR 1.47(a) and 1.137(b)

SIR:

Background

The present paper is a supplement to the renewed petitions dated 25 September 2003. Those petitions related to a series of petitions for revival of an abandoned patent application pursuant to 37 CFR 1.137(b) for unintentional abandonment and 37 CFR 1.47(a) as to the declaration requirements where there exists an uncooperative or unavailable inventor.

EV400681959US

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**CHANGE OF
CORRESPONDENCE ADDRESS**
*Application*Address to:
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450.

Application Number	09/701,797
Filing Date	December 1, 2000
First Named Inventor	Hersch
Art Unit	Unknown
Examiner Name	Unknown
Attorney Docket Number	PA1675US

Please change the Correspondence Address for the above-identified patent application to:

☒ Customer Number : 22830**RECEIVED**

MAR 19 2004

OR

☐ Firm or
Individual Name

Technology Center 2100

Address

Address

City

State

Zip

Country

Telephone

Fax

This form cannot be used to change the data associated with a Customer Number. To change the data associated with an existing Customer Number use "Request for Customer Number Data Change" (PTO/SB/124).

I am the:

- ☐ Applicant/Inventor
- ☐ Assignee of record of the entire interest.
Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96).
- ☒ Attorney or Agent of record. Registration Number 33,886
- ☐ Registered practitioner named in the application transmittal letter in an application without an executed oath or declaration. See 37 CFR 1.33(a)(1). Registration Number _____

RECEIVED

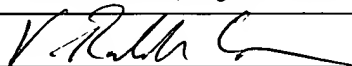
JAN 05 2005

OFFICE OF PETITIONS

Typed or Printed
Name

V. Randall Gard, Reg. No. 33,886

Signature



Date December 19, 2003

Telephone 650-812-3400

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 37 CFR 1.33. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 3 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

The co-inventor for this application, Herbert Sullivan, is deceased. Mr. Sullivan's legal representative and heir, Mrs. Joan Todd, is also deceased. Applicants have been directed, pursuant to the *Decision on Petition* dated 19 February 2003, to "seek Mr. Sullivan's current legal representative." Noting Joan Todd to be the only heir to the Sullivan estate, the *Decision* dated 19 February 2003 further directed the Applicants to "seek the heirs to Mrs. Todd's estate."

In the renewed petitions dated 25 September 2003, Applicants' representative noted it had obtained the contact information for the attorney of record for the estate of Mrs. Joan Todd. *September 25 Petition*, 2. This information was provided by the Surrogate's Court of the County of New York—the court of competent jurisdiction for the probate of the estate of Mrs. Joan Todd. *Id.*

Applicants' representative subsequently contacted Mr. Ralph M. Engel, attorney for the estate of Mrs. Joan Todd and also for Mr. Dominic Gaeta, the executor and beneficiary of the Joan Todd estate. *Id.* Mr. Engel confirmed his representation of the estate and its executor, Mr. Gaeta. *Id.*

Per Mr. Engel's request, Applicants' representative delivered a letter detailing the assistance required from Mr. Gaeta in his position as the executor and beneficiary of the Joan Todd estate and the declaration requirement for the present application. *Id.* at 2-3. Applicants' representative also provided a copy of the application and a declaration and power of attorney. *Id.* at 3. At the time the previous petition was filed on 25 September 2003, neither Mr. Gaeta nor Mr. Engel had replied as to whether they would be willing to execute the declaration for this application.

The oath and declaration of co-inventor Clifford Hersh has previously been submitted and recognized as being proper and without defect by the Patent Office. *Id.*

New Facts as They Relate to the Renewed Petitions Filed 25 September 2003

Since the filing of the renewed petitions dated 25 September 2003, Mr. Dominic Gaeta—the executor and beneficiary of the Joan Todd estate—has executed a declaration under penalty of perjury that includes, *inter alia*:

- (1) a declaration that he is "the legal representative of Ms. Joan Todd, deceased";
- (2) the citizenship of Mr. Herbert Sullivan—the United States;
- (3) the requisite declaration under 37 CFR § 1.497(a)(4) stating that Mr. Gaeta believes Mr. Sullivan to be "an original, first and joint inventor of the subject matter which is claimed and for which a patent is sought" in the present application;

- (4) the requisite declaration under 37 CFR § 1.63 as to having “reviewed and understand the contents” of the specification of the present application and further acknowledging “the duty to disclose information which is material to patentability” as defined in 37 CFR § 1.56.

Previously Submitted Renewed Petition Under 37 CFR 1.47(a)

The petition under 37 CFR § 1.47(a) is now moot as the legal representative of Mr. Sullivan—via the estate of Ms. Todd—has executed the requisite declaration along with co-inventor Clifford Hersh.

Previously Submitted Renewed Petition Under 37 CFR 1.137(b)

A proper petition under 37 CFR 1.137(b) requires:

- (1) the required reply;
- (2) the petition fee required by law;
- (3) a statement that the entire delay in filing the required reply was unintentional; and
- (4) any terminal disclaimer pursuant to 37 CFR 137(c) (where required).

Applicants previously satisfied the latter three requirements, as confirmed by the Patent Office, leaving only the submission of the required reply to revive the application. *See 30 May 2002 Decision on Petition Under 37 CFR 1.137(b)* (the “applicant has satisfied Items (2), (3) and (4)”).

Applicants contend the enclosed *Declaration and Power of Attorney for Patent Application* executed by Mr. Dominic Gaeta, the executor and beneficiary of the Joan Todd estate, in conjunction with the previously submitted and accepted declaration of Clifford Hersh hereby satisfies the requirement as to a proper reply.

CONCLUSION

In view of the foregoing, a decision in favor of a revival of the present application is respectfully requested.

Respectfully submitted,
Clifford L. Hersh et al.

Date: 19 December 2003

By: 

V. Randall Gard, Reg. No. 33,886
Carr & Ferrell *LLP*
2200 Geng Road
Palo Alto, CA 94303
Phone (650) 812-3400
Fax (650) 812-3444

DECLARATION AND POWER OF ATTORNEY FOR PATENT APPLICATION

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am an original, first and joint inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled:

Method for Increased Concurrency in a Computer System

the specification of which was filed in the U.S. Patent Office on December 1, 2000 and assigned application number 09/701,797.

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims.

I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations, §1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

I hereby claim foreign priority benefits under Title 35, United States Code §119(a)-(d) or (f) or §365(b) of any foreign application(s) for patent, inventor's or plant breeder's rights certificate(s), or §365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application for patent, inventor's or plant breeder's rights certificate(s), or any PCT international application having a filing date before that of the application on which priority is claimed:

No Foreign Priority Benefit Claimed

I hereby claim the benefit under Title 35, United States Code §119(e) of any United States provisional application(s) listed below.

No Provisional Priority Benefit Claimed

I hereby claim the benefit under Title 35, United States Code §120 of any United States application(s), or §365(c) of any PCT International application designating the United States, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT International application in the manner provided by the first paragraph of Title 35, United States Code §112, I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations, §1.56 which became available between the filing date of the prior application and the national or PCT International filing date of this application.

PCT/US99/12433

Application Number

June 3, 1999

International Filing Date

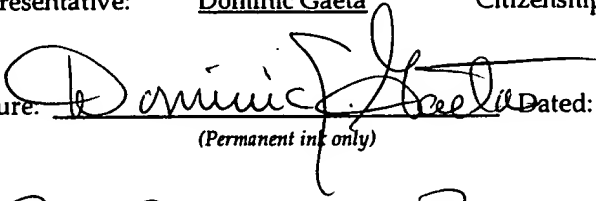
Abandoned

Present Status of Application

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States

Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full name of Legal Representative: Dominic Gaeta Citizenship: USA

Representative's signature:  Dated: 12-1-03
(Permanent int only) (Date of Signature)

Mailing Address: P.O. Box 502 Ridgewood NJ 07451
Where the legal representative normally receives mail

Residence Address: 533 Lotus Rd. Ridgewood NJ 07450
If the legal representative lives at a location different than his mailing address